REMARKS:

I. Overview

The Office Action dated September 25, 2008 has been received and carefully considered. Claims 1 and 3-53 are pending in the present application. Claims 1, 16, 29, 40, and 50 have been amended. No claims have been added. No new matter has been added

Claims 1 and 3-49 were rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. In addition, claims 1 and 3-53 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent Publication No. 2004/0123162 to Antell et al. ("Antell"), U.S. Patent Publication No. 2003/0126049 to Nagan et al. ("Nagan"), and U.S. Patent No. 5,842,195 to Peters et al. ("Peters"). These rejections are respectfully traversed. Reconsideration in light of the following remarks is respectfully requested.

II. The Claimed Invention Is Directed To Statutory Subject Matter

A. <u>Rejection of Claims 1, 16, 29, and 40 Under 35 U.S.C. 101</u>

On page 3 of the Office Action, the Examiner rejected Claims 1 and 3-49 as being allegedly directed to non-statutory subject-matter. The Applicant respectfully traverses this rejection.

The Examiner states on page 3 of the Office Action that a process must "(1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing." The Examiner asserts that "applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus." *Id.*

While the Applicant disagrees with the Office's assertion, in order to expedite prosecution, Applicant has amended Claims 1, 16, 29, and 40 to recite "an automated" method and added a recitation of computer hardware to specifically tie the claimed subject matter to a computer. Thus, amended Claims 1, 16, 29, and 40 contain appropriate subject matter under 35 U.S.C. § 101 because each recites a process as defined by 35 U.S.C. § 100(b). *See* M.P.E.P. § 2106 (IV)(B) (8th ed. rev'd July 2008). Furthermore, Claims 1, 16, 29, and 40 are not abstract ideas, natural phenomena, or laws of nature covered by any of the judicial exceptions under 35 U.S.C. 101 because the claims are tied to a particular apparatus, i.e., a computer comprising at least computer software.

Also, since the issuance of the Office Action, the Federal Circuit has created a new test for patent eligible subject matter under 35 U.S.C. 101. The new test announced in *In re Bilski*, No. 2006-1130 (Fed. Cir. Oct. 30, 2008) (*en banc*), requires that patent claims must be tied to a particular machine or apparatus, or the claims must transform a particular article into a different state or thing. Here, the amendments made to Claims 1, 16, 29, and 40 require machine implementation, i.e., a computer comprising at least computer software. Thus, Claims 1, 16, 29, and 40 are patent eligible subject matter under 35 U.S.C. 101. The Applicant respectfully requests that the rejection of Claims 1, 16, 29, and 40 under 35 U.S.C. § 101 be withdrawn and the Application be allowed and passed to issue.

B.   Dependent Claims 3-15, 17-28, 30-39, and 41-49

Claims 3-15, 17-28, 30-39, and 41-49 depend on Claims 1, 16, 29, and 40 which are patent eligible subject matter as shown above. The Applicant submits that by virtue of their dependency on Claims 1, 16, 29, and 40, Claims 3-15, 17-28, 30-39, and 41-49 are also patent eligible subject matter. The Applicant therefore respectfully requests that the rejection of Claims

3-15, 17-28, 30-39, and 41-49 under 35 U.S.C. 101 be withdrawn and the Application be allowed and passed to issue.

III. Rejections Under 35 U.S.C. § 103(A) To Antell, Peters, And Nagan

Claims 1 and 3-53 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Antell, Peters, and Nagan. This rejection is respectfully traversed.

A. Independent Claim 1

Independent claim 1 recites, *inter alia*, the steps of "determining from the overall question set a basic question set asked of all users, wherein each question of the basic question set is associated with an expected answer and wherein the basic question set comprises the minimum number of sequenced questions the answers to which would be sufficient to meet the regulatory criteria if no unexpected answers are given", "providing predetermined sequenced criteria for supplementing the basic question set with supplemental additional questions from the overall question set within the sequence of the basic question set, wherein the criteria are structured to minimize the number of remaining questions that must be answered in order to comply with the regulatory criteria", "conducting an optimized interactive customer survey, comprising: presenting each question of the basic question set to a user; receiving from the user an answer to each basic question; determining if the received answer is the expected answer for the question asked; upon a determination that the received answer is the expected answer, continuing in the basic question set sequence to the next question in the basic question set; upon a determination that the received answer is not the expected answer, presenting supplemental additional questions based on the predetermined sequenced criteria for supplementing the basic question set and returning to the sequence of the basic question set once the user provides the

expected answer to the supplemental additional questions; repeating the preceding steps above until all basic questions and required supplemental additional questions have been asked and answered; and informing the customer of completion of the survey once the customer provides answers to the minimum number of questions needed to comply with the regulatory criteria", and "wherein the preceding steps are implemented by a computer, comprising at least a computer processor."

B.   Neither Antell Nor Peters Disclose The Elements Of Claim 1

Applicant respectfully submits that Antell does not disclose, teach, or suggest the recited elements of claim 1. The Examiner alleges on page 4 of the Office Action that paragraphs 7-8 and 24 of Antell disclose "determining from the overall question set a basic question set *asked of all users* . . . ." (Emphasis added). Applicant has already addressed and overcome this rejection in a previous Office Action Response submitted to the previous Examiner. Applicant respectfully submits that the current Examiner's rejection is contrary to the previous position of the Office, and is untenable based on the clear language of Antell. Therefore, Applicant respectfully traverses this rejection.

Antell discloses using dynamic and prioritized questions within a question set to authenticate a user on a network. Antell, ¶ 7. Antell describes that the questions sets are formulated, ordered, and selected for inclusion based on their priority ranking generated from parsing external user information received from a data source. *Id.* at ¶ 8. Further, Antell describes that a user is authenticated on a network by determining whether the users responses to a question within a question set matches like information received from a data source. *See id.* at ¶¶ 6-9; Abstract.

As paragraph 7 of Antell states, there is not a single basic question set that is asked of all users, but instead "one question of a basic question type, and a plurality of questions of an authenticating type." *Id.* at ¶ 7. There is not a basic question set asked of all users because Antell is concerned with *authenticating* a user onto a network based on information from available data sources. *Id.* at ¶ 6-10; Abstract. The method disclosed in Antell "analyze[s] the responses to determine whether the *responses [to authenticating questions] match like information received from a data source(s)* that can include personal and/or corporate/business data." *Id.* at ¶ 7(emphasis added). Furthermore, Antell does not describe a question set where each question is associated with a *specific expected answer* for all users; rather, Antell describes a method wherein the expected answer is *dynamic* because each user has different authenticating information. Since the basic question set changes in Antell for each user based on the user's authenticating information, the expected answers change as well. Therefore, Antell does not disclose a basic question set that is asked of *all users*.

Furthermore, Applicant respectfully submits that neither Antell nor Peters discloses, teaches, or suggests the element of "conducting an optimized interactive customer survey, comprising: presenting each question of the basic question set to a user; receiving from the user an answer to each basic question; determining if the received answer is the expected answer for the question asked; upon a determination that the received answer is the expected answer, continuing in the basic question set sequence to the next question in the basic question set; upon a determination that the received answer is not the expected answer, presenting supplemental additional questions based on the predetermined sequenced criteria for supplementing the basic question set and returning to the sequence of the basic question set once the user provides the expected answer to the supplemental additional questions; repeating the preceding steps above

until all basic questions and required supplemental additional questions have been asked and answered; and informing the customer of completion of the survey once the customer provides answers to the minimum number of questions needed to comply with the regulatory criteria . . . ."

The Examiner states on pages 5-6 of the Office Action, "Antell et al does not explicitly teach upon a determination that the received answer is the expected answer, continuing in the basic question set sequence to the next question in the basic question set; upon a determination that the received answer is not the expected answer, presenting supplemental additional questions based on the predetermined sequenced criteria for supplementing the basic question set and returning to the sequence of the basic question set once the user provides the expected answer to the supplemental additional questions and repeating until all questions have been asked and answered." The Examiner goes on to state that Peters teaches the above limitation. *Id.* at p. 6. The Applicant respectfully disagrees.

Peters discloses a method for obtaining and collating information from a plurality of computer users having access to e-mail, and using a database to present the information obtained from these users. Peters, col. 1, lines 8-14; col. 2, lines 43-47. Peters allows the user to prepare a survey document asking information on any desired subject and includes a database with the ability to load, sort, and present this information to the user. *Id.* at col. 3, lines 23-36. The surveys described in Peters are promotional in nature, e.g., a survey question sent via e-mail to respondent users with a question like "do you like chocolate?" and if the respondent user answers yes, preparing and sending via e-mail a further survey document asking the user "would you like to have a free sample of our new chocolate bar brand X?" *Id.* at col. 4, lines 23-43.

Peters describes this style of surveys as a "'conversational' style of communication." *Id.* at col. 4, lines 44-56.

The Examiner alleges on page 6 of the Office Action that Peters teaches "a series of branched-to-questions wherein based on a specific answer (or non-answer) to a question, a series of linked questions are asked, otherwise, these branched-to-questions are not asked and the survey continues (column 5, line 49 - column 6, line 22)." Unlike the Application that asks supplemental questions only if a predetermined answer is *not given*, the supplemental questions in Peters are asked only if a predetermined answer is *given*: "the branched-to question or questions will only be required to be answered by a respondent user if the respondent (remote user) user *gives a predetermined answer* to the question or series of questions to which the branched to question is linked." Peters, col. 5, lines 51-55 (emphasis added). This makes sense when considered with the chocolate example above as there would not be a need or incentive to ask someone who does not like chocolate if they would like to try a sample of your brand of chocolate. *See id.* at col. 4, lines 44-56. Only if a respondent user answered that they liked chocolate would you offer them a free sample of your brand of chocolate. *See id.* Peters expressly teaches away from the Application in asking *more* questions of the user only if a predetermined answer is given. The Application, on the other hand, is designed to minimize the number of questions asked to each user and expected answers result in the user being asked *less* questions, not more.

Furthermore, Peters, like Antell, does not have a basic question set asked of all users as the survey document described in Peters is "'*dynamic*', in the sense that it will only present questions to a respondent user if the respondent user has made a predetermined answer or answers to a linked question or questions." *Id.* at col. 6, lines 11-14 (emphasis added). As

explained above, the Application, *inter alia*, asks a basic question set of all users where each question is associated with a specific expected answer and these questions must be answered by the user. *See* Application, ¶¶ 30, 55. Antell and Peters do not have a basic question set asked of all users; instead the questions asked are dynamic and based on the user's input.

As shown above, neither Antell nor Peters disclose, teach, or suggest the elements of Claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 103(a) be withdrawn.

C.   Nagan Does Not Render The Application Unpatentable

Claims 7-13, 20-22, 24-26, 33-35, 37-39, 43-45, and 47-49 were rejected under 35 U.S.C. 103(a) as being unpatentable over Antell, Peters, and Nagan. Applicant respectfully traverses this rejection.

Nagan does not disclose the elements of claim 1, and specifically does not disclose the element of "determining from the overall question set a basic question set asked of all users, wherein each question of the basic question set is associated with an expected answer and wherein the basic question set comprises the minimum number of sequenced questions the answers to which would be sufficient to meet the regulatory criteria if no unexpected answers are given . . . ." Nagan discloses a method for identifying and assessing risks arising from Internet and related data processing activities, as well as other risks for which historical risk assessment methodologies are not available. Nagan, ¶¶ 2, 16. As the Examiner states on page 9 of the Office Action: "Nagan [] discloses anticipated answers have predetermined risk contribution factor values. Total risk factors are calculated by adding the risk contribution factor values of each response submitted by the customer (paragraphs 46-47, 65-66)." Nagan's questions,

therefore, do not have expected answers, but instead have a limited set of potential answers that

are used to determine an overall risk assessment:

> Preferably, all the questions are drafted to yield one of a limited set of potential answers, each of which is handled by the risk assessment procedure. Thus, preferably all questions will prompt for an answer of one of "yes," "no," "don't know," or "not applicable," or will yield a numeric answer that is required to be within a given valid range. These answers provide answers or, in some cases, a numeric answer or range. The questions and their answers should be relatively objective, but it is also possible to employ the judgment of the answerer to rate his or her belief over a scale as a means to statistically distinguish one group of answerers from another (for example to assess the user's confidence in their answers).

Nagan, ¶ 37.

Nagan does not disclose the elements of claim 1, and specifically does not disclose, *inter alia*, a basic question set asked of all users where each question is associated with an expected answer. Since Nagan does not disclose the elements of claim 1, it does not cure the deficiencies of Antell and Peters. Therefore, claim 1 is patentable and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 103(a) be withdrawn.

D.   Claims 3-15

Claims 3-15 depend on independent claim 1 and must be patentable over the stated references for at least the same reasons as claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 3-15 under 35 U.S.C. 103(a) be withdrawn.

E.   Independent Claim 16

Independent claim 16 recites, *inter alia*, the steps of "displaying . . . at least one question asked of all users having an associated single expected answer . . . selected from an overall question set comprising all possible questions for which answers may be required in order to comply with the regulatory criteria, wherein the at least one question comprises the minimum

number of sequenced questions the answers to which would be sufficient to meet the regulatory

criteria if no unexpected answers are given."

The Examiner rejected claim 16 on the same basis as claims 1 and 3-15. The remarks

and arguments with respect to claim 1 above are equally applicable to claim 16, and are herein

incorporated. Accordingly, Applicant respectfully request that the rejection of claim 16 under 35

U.S.C. 103(a) be withdrawn.

F.   Claims 17-28

Claims 17-28 depend on independent claim 16 and must be patentable over the stated

references for at least the same reasons as claim 16. Accordingly, Applicant respectfully

requests that the rejection of claims 17-28 under 35 U.S.C. 103(a) be withdrawn.

G.   Independent Claim 29

Independent claim 29 recites, *inter alia*, the steps of "displaying . . . at least one question

asked of all users and having an associated single expected answer . . . selected from an optimum

subset of an overall question pool comprising all possible questions for which answers may be

required in order to comply with the regulatory criteria, the optimum subset including only an

optimized set of sequenced questions, wherein the optimized set of sequenced questions

comprises the minimum number of questions the answers to which would be sufficient to meet

the regulatory criteria if no unexpected answers are received."

The Examiner rejected claim 29 on the same basis as claims 1 and 3-15. The remarks

and arguments with respect to claim 1 above are equally applicable to claim 29, and are herein

incorporated. Accordingly, Applicant respectfully requests that the rejection of claim 29 under

35 U.S.C. 103(a) be withdrawn.

H.   Claims 30-39

Claims 30-39 depend on independent claim 29 and must be patentable over the stated references for at least the same reasons as claim 29. Accordingly, Applicant respectfully requests that the rejection of claims 30-39 under 35 U.S.C. 103(a) be withdrawn.

I.   Independent Claim 40

Independent claim 40 recites, *inter alia*, "a question optimization module adapted for structuring a sequenced optimized question set having at least one question asked of all users that is selectively displayable to the user, . . . and wherein the question optimization module is adapted to supplement the sequenced optimized question set with additional questions from an overall question set after receiving answers from the user that differ from the expected answer to comprise the minimum number of remaining questions that must be answered in order to comply with the regulatory criteria."

The Examiner rejected claim 40 on the same basis as claims 1 and 3-15. The remarks and arguments with respect to claim 1 above are equally applicable to claim 40, and are herein incorporated. Accordingly, Applicant respectfully requests that the rejection of claim 40 under 35 U.S.C. 103(a) be withdrawn.

J.   Claims 41-49

Claims 41-49 depend on independent claim 40 and must be patentable over the stated references for at least the same reasons as claim 40. Accordingly, Applicant respectfully requests that the rejection of claims 41-49 under 35 U.S.C. 103(a) be withdrawn.

K.   Independent Claim 50

Independent claim 50 recites, *inter alia*, "displaying at least one question asked of all users and having an associated single expected answer, . . . wherein the at least one question

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comprises the minimum number of sequenced questions the answers to which would be sufficient to meet the regulatory criteria if no unexpected answers are given."

The Examiner rejected claim 50 on the same basis as claims 1 and 3-15. The remarks and arguments with respect to claim 1 above are equally applicable to claim 50, and are herein incorporated. Accordingly, Applicant respectfully requests that the rejection of claim 50 under 35 U.S.C. 103(a) be withdrawn.

L.   <u>Claims 51-53</u>

Claims 51-53 depend on independent claim 50 and must be patentable over the stated references for at least the same reasons as claim 50. Accordingly, Applicant respectfully requests that the rejection of claims 51-53 under 35 U.S.C. 103(a) be withdrawn.

IV.   CONCLUSION

For at least the reasons set forth above, the Applicant respectfully submits that claims 1 and 3-53 are in condition for allowance. The Applicant therefore requests that the Application be allowed and passed to issue.

Should the Examiner believe anything further is desirable in order to place the Application in even better condition for allowance, please contact the Applicant's undersigned representatives.

Respectfully submitted,

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